



UNITED STATES
PATENT AND
TRADEMARK OFFICE

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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WILLIAM F. GADIANO, ESQ.
McDERMOTT, WILL AND EMERY
600 13TH STREET, NW
WASHINGTON, DC 20005

In re Application of :
Marc J. McKennon et al :
Serial No.: 09/859,503 : PETITION DECISION
Filed: May 18, 2001 :
Attorney Docket No.: 44033-122 :

This letter is in response to the petition under 37 CFR 1.181, filed January 6, 2003, requesting withdrawal of an objection made by the examiner.

BACKGROUND.

A review of the file history shows that the examiner mailed a first Office action to applicants on January 2, 2002, setting a three month shortened statutory period for reply. The Office action rejected claims 1-36 under 35 U.S.C. 112, first and/or second paragraphs, for a number of reasons. No rejection over prior art was made. Applicants replied on April 2, 2002, and amended claims 1, 4, 6, 34 and 36, canceled claim 3 and added claim 37, and addressed all of the rejections.

The examiner mailed a second Office action to applicants on May 29, 2002, again rejecting claims 1-36 (sic 1-2 and 4-37) under 35 U.S.C. 112, first and/or second paragraphs, for reasons previously set forth as well as new reasons. Claims 4-7 were objected to as being of improper dependent form for failure to further limit the claim(s) from which they depend, namely claim 37. Applicants replied on September 30, 2002, by amending claims 1-2, 6 and 37 and by addressing all of the rejections and arguing that the objection set forth in the last Office action was improper.

The examiner mailed a Final Office action to applicants on November 5, 2002, again setting forth rejections of claims 1-37 (sic 1-2 and 4-37) under 35 U.S.C. 112, first and/or second paragraphs, for reasons previously set forth with further explanations in response to applicants' arguments. The objection to claims 4-7 was also maintained as being improperly dependent as not further limiting the claim(s) from which they depend. No amendment after Final Office action has been

submitted. However a Notice of Appeal was filed on December 9, 2002. This petition followed on January 6, 2003.

DISCUSSION

Applicants contend that the examiner is misinterpreting claim 37 when considering claims 4-7. Claim 4 depends on claim 37 which is an independent claim and claims 5-7 depend on claim 4. Claim 37 contains definitions of each of the variables of the structural formulas presented. The dispute centers around the definitions of R_2 and R_3 which in claim 37 are defined as:

independently selected from a (sic an) unsubstituted or substituted member of the group consisting of methyl....and methylphenyl. (Emphasis added)

Claim 4 further defines R_2 and R_3 as being:

substituted with one or more members of the group consisting of hydroxyl....substituted carbocyclic group.

The examiner's argument states that R_2 and R_3 are limited to those specific members set forth in the definition of claim 37 which does not include such choices as carboxyl or heterocyclic. The examiner interprets the term "substituted" in claim 37 as referring to substituents already present in the members of the group and indicates that no further substitutions are provided for in the specification. Applicants, however, refer the examiner to pages 32 and 33 of the specification which contains language similar, if not identical, to that of claims 37 and 4-7 as they depend from claim 37. Thus applicants interpretation of the claim language that "substituted" refers to each member of the group being further substituted by one or more other groups is found to be the proper interpretation. This is evidenced by inclusion in claim 37 of group members such as "ethyl and hydroxyethyl, isopropyl, n-propyl and hydroxypropyl," etc. Each of these groups can be further substituted. Further evidence is provided in Table 1, example 7, of the specification (page 60) which shows R_2 to be aminodimethyl and by Table 3, example 4, which also shows R_2 to be aminodimethyl, which is not specifically included in the definition of substituted R_2 in claim 37, but is included within the added definitions of substituted R_2 in claim 4. The examiner's narrow interpretation of "substituted" in claim 37 is in error.

DECISION

The petition is **GRANTED**. The objection of the examiner set forth in the last Office action is withdrawn.

Applicants remain under obligation in view of the Notice of Appeal filed December 9, 2002, to file an Appeal Brief within the time set forth under 37 CFR 1.192(b) or as may be extended under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

A handwritten signature in black ink, appearing to read "Bruce M. Kisliuk". The signature is stylized with a large, looped "B" and "K".

Bruce M. Kisliuk
Director, Technology Center 1600